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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,073	04/27/2001	Satoshi Okamoto	2576-108	9256

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EXAMINER

POKER, JENNIFER A

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,073

Applicant(s)

OKAMOTO ET AL.

Examiner

Jennifer A. Poker

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on February 4, 2003, relating to claims 1 and 10 have been fully considered by they are not persuasive.

2. Applicant's arguments with respect to claim 2 have been considered but are moot in view of the new ground(s) of rejection.

a. Regarding applicant's arguments to claims 1 and 10 that Kimura does not teach, disclose, nor suggest a film in the form of a sheet. The applicant incorporates the limitation "...wherein said film is in the form of a sheet," however, the applicant, himself, does not use the term "sheet" within the disclosure of his invention, nor does he describe it. This is addressed further in the art rejection below.

b. Regarding applicant's argument to claim 2 that whether or not a colored transparent layer would be acceptable or not is of no relevance to a rejection under 35 U.S.C. 102(b), the examiner has incorporated below, an art rejection under 35 U.S.C. 103(a) relating to this subject matter.

c. Objection to the drawings has been withdrawn

d. Objection to the claims has been withdrawn

Responding to the applicant's note of allowable subject matter in reference to claims 4 and 9 due to no specific grounds of rejection being lodged against them, the art rejection *had* been previously incorporated into the Kimura (US 6,322,875) art rejection; however, the claim numbers had been inadvertently unincorporated. This has been remedied in the below art rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 10, the applicant has incorporated the limitation, "...wherein said film is in the form of a sheet." The applicant, however, does not include the term "sheet" within the specification. It was understood by the examiner that the description on page 2 lines 21-23 regarding the film was describing the sheet-like formation. The applicant stated, "...a film which is formed over the surface of the undercoat layer so as to cover the undercoat layer..." Therefore, the term, "sheet" was understood to be the film formed over the surface of the undercoat layer so as to cover it, which Kimura (US Patent Number 6,322,875) clearly illustrates. Prior art was applied accordingly.

Regarding claim 13, the applicant states, "...wherein said undercoat layer is formed by depositing metal on the film." It was not understood how this could be accomplished. Previously noted in claim 13, the applicant states that the undercoat layer is formed on a surface of the base body, and then a film is formed over the surface of the undercoat layer.

How can the undercoat layer be formed by depositing metal on the film, if the film is located on the undercoat layer?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-8, and 9-13 are rejected under 35 U.S.C. 102(b) as being unpatentable by U.S. Patent Number 6,322,875 to Kimura.

Regarding claims 1, 5-8, and 9-12, Kimura discloses a layered key top for assembly in a push button switch comprising:

- (1) A base key top (Abstract) (Figures 4 and 5);
- (2) An inorganic thin membrane on the surface or backside of the key top, characterized by rainbow-colored luster. (Abstract) (Figures 4 and 5); inorganic thin film made of metal materials such as aluminum, platinum, copper or alloy, metallic oxide, etc; (Column 3, lines 32-35)
- (3) A transparent high polymer protective membrane on the surface of the inorganic thin membrane; (Abstract) (Column 5, lines 61-67) (Figures 4 and 5)

Because applicant does not describe in the claim or the specification what the term, “sheet” meant, or what is meant by “the form of a sheet”, it was understood that a form which covers the surface is what is meant. As shown by the applicant in his illustration 1, the film layer covers the playing layer. This is also shown in illustrations 1-7 of Kimura. A protective membrane covers the surface of an inorganic thin membrane.

- (4) (Known in conventional methods) A method of metal plating is used for placing layers upon surfaces of others; (Column 1, lines 13-22)

Art Unit: 2832

(5) A layer between the base and the inorganic thin membrane, in order to protect the printed layer of a letter or symbol; (Figure 7) (Column 7, lines 31-32)

(6) An operating portion; (Column 2, lines 37-39)

(7) A hollowed section located at the bottom end of the switch. (Figure 6)

Claims 10-12 are method counterparts to product claim 1, and steps are inherent for fabricating a press button switch as claimed by the inventor.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4 and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,322,875 to Kimura.

Regarding claims 2 and 3, Kimura discloses the claimed invention except for the transparent film being colored (claim 2) or the transparent film being colorless (claim 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to either use a colored film or a colorless film (one or the other would have to be used), since applicant has not disclosed that the color film, as claimed in claim 2, or the colorless film, as claimed in claim 3, solves any stated problem or is for any particular purpose and it appears that the invention would perform

Art Unit: 2832

equally well with either colored or colorless. The applicant even states on page 2, line 33 and on page 3 line 4 that either one is preferable.

Regarding claim 4, Kimura states that an inorganic thin membrane with transmittance acts as a third layer; (figure 6) (Column 3, lines 13-14)

Regarding claim 13, Kimura discloses the claimed invention except for the undercoat layer being formed by depositing metal on the film, however he does disclose deposition methods in general.

Although the product claim is limited by and defined by the recited process, "...formed by depositing metal on the film," the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985)

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Poker whose telephone number is 703-305-4037. The examiner can normally be reached on 6:00-3:30, Mon.-Fri. (alternating Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on 703-308-7619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Art Unit: 2832

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

jap
April 4, 2003


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100